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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,172	07/21/2003	Hansen Wat	200300713-1	2726

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

CHRISTENSEN, SCOTT B

ART UNIT	PAPER NUMBER
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2144

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/623,172	Applicant(s) WAT ET AL.	
	Examiner Scott Christensen	Art Unit 2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in regards to the most recent papers filed on 7/21/2003.

Priority

2. This application is a continuation in part of application 09/955,044, which is referred to in lines 2-5 of page 1 of the specification. The information provided here, though, should be amended to indicate the current status of application 09/955,044.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 19 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 19 is drawn towards a computer readable medium. According to page 8, lines 16-17, a computer readable medium may include "a carrier wave from the Internet or other network." Claims that are directed towards transmission media encoded with software are held to be nonstatutory, and in the case of claim 19, the claim is directed towards transmission media as well as physical media. See MPEP 2106.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim includes the term "reduced functionality computer." It is not clear what scope the term "functionality" is intended to have. For purposes of prosecution, it is assumed that a normal functionality computer is a standard desktop computer, and a reduced functionality computer is any computer that has any less functionality, such as a laptop, PDA, cellular phone, hand held PC, etc.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 4-8, 11-14, 18, 19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Toomey et al. in US Patent number 6,119,147, hereafter referred to as "Toomey."

With regard to claim 1, Toomey discloses a system for communicating images for a meeting, comprising: a plurality of computers controlled by meeting participants (Toomey: Figure 2 and column 5, lines 33-55); a storage device capable of storing one or more collections of expressive images of each meeting participant (Toomey: Column 7, lines 18-45. The avatars are interpreted as being the "expressive images." As

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Toomey's disclosure is intended to run on computer systems, there is inherently a storage device of some sort. Any storage device that would be used in Toomey can inherently store one or more collections of expressive images. The term "capable" does not actually require that the collection of images actually be stored on the storage device. In the case of Toomey, there are predefined avatars and user created avatars that can be selected, meaning that some storage device must be storing them.); a software application enabling each meeting participant to select an expressive image from the one or more collections of expressive images (Toomey: Column 7, lines 18-30); a network connecting the plurality of computers (Toomey: Column 2, lines 3-11), wherein each meeting participant communicates the selected expressive image to other meeting participants over the network during the meeting (Toomey: Column 7, lines 35-45. If the avatar is updated, the image is transmitted to the server to update the image on the computers of all the users.).

With regard to claim 4, Toomey discloses that the selected expressive image is transmitted to a server over a network (Toomey: Column 7, lines 35-45).

With regard to claim 5, Toomey discloses that the selected expressive image is transmitted to a designated host over the network (Toomey: Column 7, lines 35-45. Each computer on the network constitutes a host, and each one is a designated host for receiving the image from the server.).

With regard to claim 6, Toomey discloses that the selected expressive image is transmitted to other computers on the network (Toomey: Column 7, lines 35-45. The image is sent from the server to each other computer.), and that each computer can

simultaneously function as both a host and a client (Toomey: Column 7, lines 35-45. This limitation is interpreted as being intended use, as the word "can" means that the computer is able to simultaneously function as both a host and a client, which any general purpose computer with a network interface is capable of doing. In the case of Toomey, the server requests the information from the computer, and the computer serves the information, which makes the computer the host and the server the client. In other circumstances, the computer is the client and the server is the host.).

With regards to claim 7, Toomey discloses that the software application comprises modules for generating: a photo control window capable of selecting the expressive image from one or more collections of expressive images (Toomey: Column 7, lines 18-45); and a photo display window capable of displaying the selected expressive image on each meeting participant's computer (Toomey: Figure 4).

With regards to claim 8, Toomey discloses that the software application allows each meeting participant to enter text labels associated with the selected one or more expressive images (Toomey: Column 6, lines 38-48. The system of Toomey does not block the user from entering labels associated with the selected one or more expressive images, therefore it is allowed. The claim language does not require any specific form of the text label, or that the text label be displayed as part of the meeting. The file name of the image could be the text label. In this case, Toomey happens to show that text can be entered and displayed on the image, as a text utterance, which constitutes another possibility of text label.).

With regards to claim 11, Toomey further discloses that the storage device is located on a server (Toomey: Column 7, lines 35-45. As the storage device only needs to be capable of storing the collection, but does not need to actually store it according to the language of claim 1, the server's storage device can be the storage device as recited in claims 1 and 11.).

With regards to claim 12, Toomey (Toomey: Column 7, lines 18-30. As the storage device only needs to be capable of storing the collection, but does not need to actually store it according to the language of claim 1, the client's storage device can be the storage device as recited in claims 1 and 11.).

With regards to claims 13, 19, and 21, the invention as claimed is substantially similar to the subject matter claimed in claim 1, and are rejected for substantially similar reasons.

With regard to claim 14, Toomey discloses enabling the meeting participant to select a second expressive image to replace the first expressive image, wherein the second expressive image is communicated to other meeting participants' computers over the network (Toomey: Column 7, lines 35-45. During the meeting, the user's avatar can be changed and eventually transmitted to all the other users.).

With regards to claim 18, the claim is substantially similar to claim 8, and is rejected for substantially similar reasons.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2, 3, 9, 10, 15-17, 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Toomey in view of knowledge possessed by a person of ordinary skill in the art.

With regard to claim 2, Toomey discloses the invention as substantially claimed except that one or more of the plurality of computers are reduced functionality computing devices.

A person of ordinary skill in the art would have known how to implement the system of Toomey on a reduced functionality computing device (This term is extremely broad, and covers many different devices such as a standard laptop computer.).

It would have been obvious to a person of ordinary skill in the art to implement Toomey's system using one or more reduced functionality computing devices.

The suggestion/motivation for doing so would have been that reduced function computers allow the user more freedom with location. A laptop, for example, is small enough to be carried, has a battery, and includes all the components in one casing that is required to implement any function that a regular desktop can perform (though at slightly slower speeds, thus, reduced functionality computing device.). This allows a user to not be restricted to a desk, but can instead have the meeting in an environment

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that the user finds to be comfortable. Also, satellite offices can be set up more readily using laptop computers, as the multiple larger components that are required for a desktop or tower computer are replaced with one device.

With regards to claim 3, Toomey discloses the invention as substantially claimed except that the expressive images are photographs of the meeting participant.

A person of ordinary skill in the art would have known how to use photographs for the avatars of Toomey. In fact, the examiner has used his own photograph for buddy icons for AOL Instant Messenger prior to 2001, where the buddy icon is similar to the avatars of Toomey.

It would have been obvious to a person of ordinary skill in the art to use photographs of the participants for the avatar of Toomey.

The suggestion/motivation for doing so would have been that Toomey allows users to customize the avatars (Toomey: Column 7, lines 18-30). This customization would allow the user to create an avatar based on the user's photograph, allowing the user a greater degree of customization, and allowing other users to know what he/she looks like in real life. Also, the teachings of Toomey show that the user avatars are photographic images (Toomey: Column 11, lines 6-10). As the avatars are already photographic images, it makes sense to have the avatars being photographic images of the participant that the avatar represents.

With regard to claim 9, Toomey discloses the invention as substantially claimed except that the system further comprises a digital camera operatively connected to one

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of the plurality of computers for acquiring photographs of a meeting participant during a meeting.

A person of ordinary skill in the art would have known how to have a digital camera connected to the system of Toomey that can take photographs of a meeting participant during a meeting.

Evidence of this can be found in US Patent number 7,065,711 to Hata et al., hereafter referred to as "Hata." Hata discloses a system that detects facial expressions of the meeting participant that can change based on variation of facial expressions of a meeting participant based on pictures picked up by a digital camera during the meeting. (Hata: Column 9, lines 5-15).

It would have been obvious to a person of ordinary skill in the art to have a camera connected to the system of Toomey that can take pictures of a meeting participant during a meeting.

The suggestion/motivation for doing so would have been that by having a digital camera connected to a computer, the user can take photographs. The claim language does not require that the photographs of the meeting participant to actually be taken. Even so, a person of ordinary skill in the art would have been motivated to connect a digital camera to the computer and take pictures during the meeting of the meeting participant in order to automatically select expressive images to display or to take additional images to create new expressive images to be distributed to other meeting participants.

With regard to claim 10, Toomey discloses the invention as substantially claimed except that the system further comprises a video camera operably connected to one of the plurality of computers for acquiring real-time video of a meeting participant during a meeting.

A person of ordinary skill in the art would have known how to connect a video camera to a computer that can take video of a meeting participant during a meeting.

Evidence of this can be found in US Patent number 7,039,676 to Day et al., hereafter referred to as "Day." Day discloses a system where a camera is utilized to detect gestures of the user and automatically transmit information based on the gesture (Day: Column 5, line 54 to column 6, line 10 and figure 3).

It would have been obvious to a person of ordinary skill in the art to connect a video camera to one of the computers that can take video of a meeting participant during a meeting.

The suggestion/motivation for doing so would have been that by having a video camera connected to a computer, the user can take video and transfer it to the computer. The claim language does not require that any video actually be taken or transmitted. Even so, a person of ordinary skill in the art would have been motivated to take video during the meeting so that video transmission can occur during the meeting. Even though Toomey disclosure is an alternate solution to having video transmitted to each participant, having video transmitted between only two participants is a feasible improvement over Toomey's disclosure. Likewise, the video could be used to automatically display certain expressive images or text labels based on gestures of the

user, allowing common animations and text labels that would be displayed in Toomey's system to be displayed when the gesture occurs rather than having to be typed each individual time.

With regards to claims 15 and 20, the claims are substantially similar to claim 9, and are rejected for substantially similar reasons.

With regards to claim 16, the claim is substantially similar to claim 10, and is rejected for substantially similar reasons.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

In US Patent number 5,880,731 to Liles et al., a system for a graphic chat system using avatars to represent different users is disclosed. The avatar can perform different gestures, which constitutes different expressive images which are selected indirectly by the user.

In US Patent number 6,522,333 to Hatlelid et al., a system for remote communications is disclosed where the user can select different pictures to represent the user's mood to be transmitted to other users in a text session.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Christensen whose telephone number is (571)

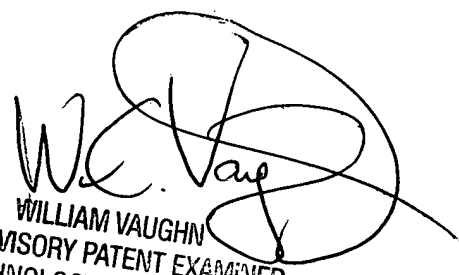
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270-1144. The examiner can normally be reached on Monday through Thursday
6:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vaughn William can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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